

DOCKET NO.: 133087.01701 (Z70402-1P US)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: **Bernstein, Dedinas, Ohnmacht, Russell, and Sherwood**

Serial No.: **09/806,657**

Group Art Unit: **1625**

Filed: **May 29, 2001**

Examiner: **Rita J. Desai**

Confirmation No.: **4679**

Title: **Naphthalenecarboxamides As Tachykinin Receptor Antagonists**

Filed via EFS Web

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO THE RESTRICTION REQUIREMENT

The Office has restricted claims 1-7 and 12-17 into ten groups. **Applicants elect Group III containing claims 1-7, 12-14, and 16 “drawn to compounds wherein R1 is the piperidine ring moiety and R2 is H”, with traverse.**

Even if the Office considers the groups of claims to be patentably distinct, §803 of the M.P.E.P. mandates two criteria for a proper requirement for restriction: 1) the inventions must be independent or distinct; **and** 2) there must be a serious burden on the examiner. For purposes of initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02. Significantly, the Office has not met the *prima facie* burden. Indeed, the Office has not shown separate status in the art or a requirement for a different field of search. Further, the groups of claims have not been identified as belonging to different classes, thus, indicating a lack of serious burden. Accordingly, *all pending claims* should be examined in the present application without restriction.

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121.

The Commissioner is hereby authorized to charge any deficiencies of fees and credit any overpayments to Deposit Account No. 50-0436.

Respectfully submitted,

/Paul K. Legaard, Reg.#38,534/
Paul K. Legaard

Date: 17 October 2007

Pepper Hamilton LLP
400 Berwyn Park
899 Cassatt Road
Berwyn, PA 19312-1183

Telephone: 610.640.7859
Facsimile: 267.430.7647